

Neifeld Docket No: CAT/34-SCRO-CCP

Application/Patent No: 09/505,632

USPTO CONFIRMATION NO: 5917

File/Issue Date: 2/16/2000

Inventor/Title: Scroggie

Examiner/ArtUnit: Robinson Boyce/3628

Date Appeal Filed: January 29, 2007

Appeal Docket Number: 2009-9673

37 CFR 41.52 REQUEST FOR REHEARING

The panel overlooked or misapprehended the following points.

POINT 1

The "Decision On Appeal" dated 3/11/2001 (herein after Decision) makes the following incorrect conclusion of law: "The claim only requires that the Internet separate the remote web site from the consumer computer, but not the remote site from the manufacturer's web site." Specifically, the conclusion that claim 24 does not define that the "Internet separate[s] ... the remote site from the manufacturer's web site" is legal error. Claim 24 recites "transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;" That recitation defines the "Web site of said manufacturer" to be separated by the Internet from the "remote Web site." Therefore, claim 24 does define that the "Internet separate[s] ... the remote site from the manufacturer's web site" is legal error.

The Decision relies upon that incorrect conclusion of law at 7:13-25 as the basis for affirming the examiner's rejection of claim 24. Examiner's Answer dated 3/17/2008 at 10 and 11, relied upon the ICN correspond to both claim 24's "Web site of a manufacturer" and "remote web site". In other words, the Decision at 7:13-25 affirming the examiner is based upon the rationale presented by the examiner's rejection of claim 24 as allegedly obvious. The conclusion affirming the examiner on that basis is not supportable since it relies upon the noted incorrect conclusion of law; the same one apparently made by the examiner. Accordingly, the appellant requests rehearing in this point and a revised decision clearly abandoning this basis for affirmance.

POINT 2

The Decision at 8:1-15 presents an alternative basis to affirm the examiner's obviousness rejection of claim 24. There, the Decision assumes *arguendo* that "reading claim 24 to require the remote Web site and the Web site of said manufacturer be separated by the Internet." That is, the Decision assumes the correct claim construction for claim 24. The Decision at 8:1-5 concludes that claim 24 is nevertheless obvious in view of Jovicic on the theories that:

- (1) "both implementations are within the level of skill of the ordinary artisan,"
- (2) "because centralized and distributed computer implementations are old and well known,"
- (3) "different modules of computer code are commonly used to do different elements of work, ... having the code modules operate in distributed web sites with remote inter-process communications between them, does not alter the function collectively performed by the several modules."

In response, the appellant notes that this is not a basis for rejection raised by the examiner in the Examiner's Answer. It is also not a basis of rejection that could reasonably have been anticipated by the appellant for the reasons noted below. Therefore, the appellant has not had a "fair opportunity to react to the thrust of the rejection" Ex parte Werner K. Maas and Carlton L. Gyles, 1987 Pat. App. LEXIS 18; 9 USPQ2d 1746; 14 USPQ2d 1762 (BPAI 1987), citing In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). Therefore, failure to designate this alternative basis of rejection as a new ground of rejection, which entitles the appellant to respond, is procedural error. Accordingly, at a minimum, the panel should reissue its decision under 37 CFR 41.50(b) expressly stating the new ground of rejection, to afford the appellant procedural relief provide by that rule.

POINT 3

The appellant submits that the alternative basis for affirmance of the rejection of claim 23, at Decision 8:1-15, makes no sense. It is a set of 3 general assertions of fact unrelated to the limitations of claim 24, and is followed without any explanation by a conclusion that claim 24 would have been obvious. The conclusion is a non sequitur. Therefore, this alternative basis for rejection is not comprehensible, and therefore could not have been anticipated by the appellant. To show why it could not have been anticipated, we address the three alleged factual underpinnings presented at 8:1-15, in sequence:

The Decision asserts that (1) "both implementations are within the level of skill of the ordinary artisan," - That statement is not relevant to obviousness. That statement is not relevant to whether the claimed steps are non obvious over the prior art.

The Decision asserts that (2) "centralized and distributed computer implementations are old and well known," - That statement is not relevant to obviousness. That statement is not relevant to whether the claimed steps are non obvious over the prior art.

The Decision asserts that (3) " different modules of computer code are commonly used to do different elements of work, ... having the code modules operate in distributed web sites with remote inter-process communications between them, does not alter the function collectively performed by the several modules." - That statement is not relevant to obviousness. That statement is not relevant to whether the claimed steps are non obvious over the prior art.

None of the assertions at Decision 8:1-15 support a conclusion of obviousness of the process steps defined by claim 24. There is no relevant analysis corresponding claim recitation to assertion of what was allegedly known in the art, and in fact even no identification of the

relevant claim recitations.

Claim 24 is a method claim, which in part recites use of a consumer computer, the Internet, a Web site of a manufacturer, and a remote Web site to achieve a particular goal: the Web site of said manufacturer transmitting to the consumer computer an incentive offer in association with a name and address of a retailer (at which the incentive offer can be exercised) provided by a remote Web site. Decision 8:1-15 does not contain any factual assertions supporting a conclusion that claim 24's concept was suggested by the prior art.

The Decision selected claim 24 as exemplary. Accordingly, the reasoning above applies to all claims in the group discussed with respect to claim 24.

POINT 4

Decision 9:1-12 affirm the obviousness rejection of claims 50 and 51 on the same grounds and reasoning as claim 24. Accordingly, the reasoning noted above for claim 24 applies to claims 50 and 51.

Truly,

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Date/time code: March 11, 2011 (4:13pm)

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